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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,798	12/11/2003	N. Isaac Rajkumar	VIGN1640-1	8964
44654	7590	05/31/2006	EXAMINER	
SPRINKLE IP LAW GROUP 1301 W. 25TH STREET SUITE 408 AUSTIN, TX 78705			PATEL, HETUL B	
			ART UNIT	PAPER NUMBER
			2186	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,798

Applicant(s)

RAJKUMAR ET AL.

Examiner

Hetul Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/13/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communication filed on April 03, 2006. This amendment has been entered and carefully considered. Claims 36-38 are newly added, therefore, claims 1-38 are pending in this application.
2. The IDS filed on 02/13/2006 has been received and carefully considered.
3. Applicant's arguments filed on April 03, 2006 have been fully considered but they are not persuasive.
4. The rejection of claims 1-35 as in the previous Office Action is respectfully maintained and reiterated below for Applicant's convenience. Newly added claims 36-38 are rejected based on a new ground(s) of rejection.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 36 and 37 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 44 and 45 of copending Application No. 10/733,742.

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This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

7. Claims 36 and 37 of this application conflict with claims 44 and 45 of Application No. 10/733,742. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-9, 15-17, 18-26 and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Shen (USPN: 5,946,697).

As per claim 1, Shen teaches a method for caching comprising registering a module (i.e. the macro definition file); evaluating a parameter (i.e. macro name file) of a request, wherein the parameter is evaluated by the module; creating a signature (i.e. the macro compressed file) based on the evaluation; searching for responsive content (i.e. the changed HTML file content/portion) in a cache based on the signature; and generating responsive content and storing it in the cache if no responsive content is found in the cache (i.e. transmitting the changed HTML file content from the server location to the client location) (e.g. see Col. 2, line 57 – Col. 3, line 21).

As per claim 2, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the method further comprising receiving a request (e.g. see Col. 3, lines 35-40).

As per claim 3, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the method further comprising delivering the responsive content to an originator of the request (e.g. see Col. 3, lines 45-46).

As per claim 4, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the method further comprising registering a template (i.e. the macro definition file) (e.g. see Col. 2, line 65 – Col. 3, line 2).

As per claim 5, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the method further comprising associating the request with the template (i.e. the macro definition file) (e.g. see Col. 2, line 65 – Col. 3, line 2).

As per claim 6, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the method further comprising the parameter (i.e. the

macro name file) is defined by the template (i.e. the macro definition file) (e.g. see Col. 2, line 65 – Col. 3, line 2).

As per claim 7, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the method further comprising extracting data related to the parameter from the request; and passing the data to the module, i.e. the macro compressed file, which indicates the changes made to the changed HTML portion relative to the HTML file cached at the client location, is generated at the server location and passed/transmitted to the client location from the server location (e.g. see Col. 3, lines 5-14).

As per claim 8, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the parameter (i.e. the macro name file) is a form data and a java bean (e.g. see Col. 6, lines 41-53).

As per claim 9, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the signature (i.e. the macro compressed file) is formed from the module's evaluation (i.e. the evaluation of the macro definition file) (e.g. see Col. 3, lines 5-7).

As per claim 15, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the method further comprising storing template metadata (i.e. macro name file) and request metadata (i.e. the macro compressed file) in the cache, wherein the template metadata and request metadata are associated with the responsive content (i.e. the changed HTML file content/portion) (e.g. see Col. 2, line 57 – Col. 3, line 21).

As per claim 16, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the request metadata (i.e. the macro compressed file) is formed from the module's evaluation (e.g. see Col. 2, line 57 – Col. 3, line 21).

As per claim 17, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the request metadata (i.e. macro name file) is a list or a hash table (i.e. the list of macro names) (e.g. see Col. 2, line 57 – Col. 3, line 21).

As per claims 18-26 and 32-34, see arguments with respect to the rejection of claims 1-9 and 15-17, respectively. Shen teaches the software system having machine/computer readable media (i.e. the memory medium) containing machine instructions, which when executed cause to implement functions that are generally consistent with the steps of the method of claims 1-9 and 15-17 (e.g. see Col. 3, lines 54-60). Claims 18-26 and 32-34 are also rejected based on the same rationale as the rejection of claims 1-9 and 15-17, respectively.

9. Claims 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Connell, Jr. et al. (USPN: 7,024,452) hereinafter, O'Connell.

The applied reference has a common assignee and inventor(s) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this

application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As per claim 36, O'Connell teaches a method for caching, comprising:

- receiving a request (i.e. step 402 in Fig. 4);
- storing first content (i.e. the caching content component) responsive to the request in a cache (i.e. step 626 in Fig. 6);
- associating first metadata (i.e. the mapped filename) with the first content, wherein the first metadata is determined by evaluating a parameter of the request (i.e. by parsing the request; steps 422 and 424 in Fig. 4);
- regenerating the request based on the first metadata associated with the responsive content (i.e. checking whether the requested data is in the cache; step 426 in Fig. 4);
- obtaining second content responsive to the request (i.e. step 502 in Fig. 5);
and
- replacing the first content with the second content in the cache (i.e. step 562 in Fig. 5) (e.g. see Figs. 4-6 and Col. 6, lines 59+).

As per claim 37, O'Connell teaches the claimed invention as described above and furthermore, O'Connell teaches that the method further comprising:

- receiving second metadata (i.e. receiving the second/next request for a different file; step 402 in Fig. 4);;
- comparing the second metadata to the first metadata to identify the first content (i.e. step 562 in Fig. 5); and

- storing content responsive to the request in a cache (i.e. step 564 in Fig. 5)
(e.g. see Figs. 4-6 and Col. 6, lines 59+)..

As per claim 38, O'Connell teaches the claimed invention as described above and furthermore, O'Connell teaches that the first metadata is determined by a module (i.e. the software module) (e.g. see Col. 4, lines 55-57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 10-14, 27-31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen in view of Bradley et al. (USPN: 2002/0194219) hereinafter, Bradley.

As per claim 10, Shen teaches the claimed invention as described above. However, Shen does not teach the further limitation that the parameter and the module pertain to capabilities of a browser initiating the request. Bradley, on the other hand, teaches that the server delivers a form and renders it in the format that best matches the presentation and form filling capabilities of the target browser, i.e. the browser initiating the request (e.g. see paragraphs [0109] and [0270]). Accordingly, it would have been obvious to one ordinary skilled in the art at the time of the current invention was made to implement the teachings of Bradley in the method taught by Shen. In

doing so, instead of presenting the data in one standard/default way, for example, font size, color, background color, etc., the data will appear on the browser as it is preferred by the user who initiated the request (e.g. see paragraph [0110]).

As per claim 11, the combination of Shen and Bradley teaches the claimed invention as described above and furthermore, Bradley teaches that the parameter is a user-agent string extracted from a header in the request (see paragraph [0280]).

As per claim 12, the combination of Shen and Bradley teaches the claimed invention as described above and furthermore, Bradley teaches that the module evaluates the capabilities of the browser using an extensible markup language file (e.g. see paragraph [0017]).

As per claim 13, the combination of Shen and Bradley teaches the claimed invention as described above and furthermore, Bradley teaches that the the extensible markup language file defines a list of rules which map the user-agent string to a list of browser capabilities (see paragraph [0281]-[0282]).

As per claim 14, the combination of Shen and Bradley teaches the claimed invention as described above and furthermore, Bradley teaches that the list of rules may be expanded, i.e. the list/table gets longer as the browser capabilities for a particular client/browser is increased (e.g. see paragraph [0281]).

As per claims 27-31, see arguments with respect to the rejection of claims 10-14, respectively. The combination of Shen and Bradley teaches the software system having machine/computer readable media (i.e. the memory medium) containing machine instructions, which when executed cause to implement functions that are

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generally consistent with the steps of the method of claims 10-14 (e.g. see Shen Col. 3, lines 54-60). Claims 27-31 are also rejected based on the same rationale as the rejection of claims 10-14, respectively.

As per claim 35, see arguments with respect to the rejection of claims 1, 10 and 12. Claim 35 is also rejected based on the same rationale as the rejection of claims 1, 10 and 12.

Remarks

11. As to the remark, Applicant asserted that

- (a) Applicant respectfully submits that a module which is designed to evaluate a parameter is not equivalent to a set of HTML constructs or lists (i.e. a macro definition file).
- (b) The Applicant respectfully submits that the macro definition file (e.g. set of HTML constructs or lists) is not operable to evaluate a set of checksums since in Shen only the macro name file is transmitted to the web server, while only the compressed file is transmitted from the server to the client. Thus, the macro name file and macro definition file of Shen are never used simultaneously by either the client computer or the web server of Shen.
- (c) Shen does not disclose at least the limitations of registering a module or evaluating a request, wherein the parameter of the request is evaluated by the module.

(d) Applicant respectfully submits that the compressed file is not created by based on the evaluation because in Shen, the macro compressed file is created by comparing the macro name file with the HTML document at the server, not on the evaluation of the macro name file by the macro definition file. Accordingly, Applicant respectfully submits that Shen does not disclose at least the limitations of creating a signature based on the evaluation.

Examiner respectfully traverses Applicant's remark for the following reasons:

With respect to (a) and (b), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the macro name file and macro definition file of Shen are never used simultaneously by either the client computer or the web server of Shen") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to (c) and (d), Examiner agrees with Applicant on the fact that in Shen, the macro compressed file is created by comparing the macro name file with the HTML document at the server, not on the evaluation of the macro name file by the macro definition file (e.g. see Col. 2, line 57 – Col. 3, line 21). Examiner interpreting and equating this with the claimed limitations, registering a module (i.e. the macro definition file); evaluating a parameter (i.e. macro name file) of a request, wherein the parameter is evaluated by the module; creating a signature (i.e. the macro compressed

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file) based on the evaluation because in order to create the macro compressed file by comparing the macro name file with the HTML document at the server, the macro definition file needs to be evaluated. Examiner would like to suggest Applicant for defining/explaining the evaluation step in more detailed steps to distinguish it from the applied prior art(s).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hetul Patel whose telephone number is 571-272-4184. The examiner can normally be reached on M-F 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on 571-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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